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Patent
Attorney Docket No. 032751-094

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of
Ronald Rooke
Application No.: 10/670,397
Filing Date: September 26, 2003
Title: ANTI-INFLAMMATORY VECTORS

Group Art Unit: 1648
Examiner: STACY BROWN CHEN
Confirmation No.: 2721

AMENDMENT/REPLY TRANSMITTAL LETTER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Enclosed is a reply for the above-identified patent application.

- ☐ A Petition for Extension of Time is also enclosed.
- ☐ Terminal Disclaimer(s) and the ☐ \$55.00 (2814) ☐ \$110.00 (1814) fee per Disclaimer due under 37 C.F.R. § 1.20(d) are also enclosed.
- ☐ Also enclosed is/are _____

- ☐ Small entity status is hereby claimed.
- ☐ Applicant(s) requests continued examination under 37 C.F.R. § 1.114 and enclose the ☐ \$385.00 (2801) ☐ \$770.00 (1801) fee due under 37 C.F.R. § 1.17(e).
- ☐ Applicant(s) requests that any previously unentered after final amendments not be entered. Continued examination is requested based on the enclosed documents identified above.
- ☐ Applicant(s) previously submitted _____

_____ on _____
for which continued examination is requested.
- ☐ Applicant(s) requests suspension of action by the Office until at least _____, which does not exceed three months from the filing of this RCE, in accordance with 37 C.F.R. § 1.103(c). The required fee under 37 C.F.R. § 1.17(i) is enclosed.
- ☐ A Request for Entry and Consideration of Submission under 37 C.F.R. § 1.129(a) (1809/2809) is also enclosed.

- ☒ No additional claim fee is required.
- ☐ An additional claim fee is required, and is calculated as shown below.

AMENDED CLAIMS					
	No. of Claims	Highest No. of Claims Previously Paid For	Extra Claims	Rate	Additional Fee
Total Claims		MINUS =	0	x \$18.00 (1202) =	\$ 0.00
Independent Claims		MINUS =	0	x \$86.00 (1201) =	\$ 0.00
If Amendment adds multiple dependent claims, add \$290.00 (1203)					
Total Claim Amendment Fee					\$ 0.00
<input type="checkbox"/> Small Entity Status claimed - subtract 50% of Total Claim Amendment Fee					\$ 0.00
TOTAL ADDITIONAL CLAIM FEE DUE FOR THIS AMENDMENT					\$ 0.00

- ☐ A check in the amount of _____ is enclosed for the fee due.
- ☐ Charge _____ to Deposit Account No. 02-4800.
- ☐ Charge _____ to credit card. Form PTO-2038 is attached.

The Director is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17, 1.20(d) and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800. This paper is submitted in duplicate.


Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620

Date: July 30, 2004

By


Deborah H. Yellin
Registration No. 45,904



Patent
Attorney Docket No. 032751-094

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)	MAIL STOP NON-FEE
Ronald ROOKE)	AMENDMENT
Application No.: 10/670,397)	Group Art Unit: 1648
Filed: September 26, 2003)	Examiner: Stacy Brown CHEN
For: ANTI-INFLAMMATORY VECTORS)	Confirmation No.: 2721

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In complete and timely response to the Office Action of June 13, 2004, Applicant submits the following response. In the Office Action [restriction requirement], the Examiner sets forth the following restriction requirement among four groups of claims:

Group I, claims 1-20, directed to a method to protect against an inflammatory condition, classified in class 514, subclass 44;

Group II, claims 21-34, directed to a method for gene transfer, classified in class 435, subclass 69.1;

Group III, claims 22-25 and 27-33, directed to a vector, particle and host cell, classified in class 435, subclass 320.1; and

Group IV, claim 26, directed to a method for preparing a viral particle, classified in class 435, subclass 70.1.

Applicant herewith elects Group III, Claims 22-25 and 27-33, directed to a vector, particle and host cell, with traverse.

The Examiner acknowledges that the inventions of Group III and Groups I, II and IV are related as process (method) and apparatus for its practice. However, the Examiner contends that the inventions of Group III and Groups I, II and IV are patentably distinct because the process as claimed can be used to make other and materially different products or the product as claimed can be made by another materially different process.

Applicant respectfully submits that the inventions of Groups III and I, II and IV are closely related and that a proper search of any of the claims should, by necessity, require a proper search of the others. Thus, Applicant submits that all of the claims can be searched simultaneously, and that a duplicative search, with possibly inconsistent results, may occur if the restriction requirement is maintained. All of the claims of all four Groups are directed to recombinant adenoviral vectors used for therapeutic and/or prophylactic purposes.

Applicant submits that any nominal burden placed upon the Examiner to search accordingly to determine the art relevant to Applicant's overall invention is significantly outweighed by the public's interest in not having to obtain and study many separate patents in order to have available all of the issued patent claims covering Applicant's invention. The alternative is to proceed with the filing of multiple applications, each consisting of generally the same disclosure, and each being subjected to essentially the same search, perhaps by different Examiners on different occasions. This process would place an unnecessary burden on both the Patent and Trademark Office and on the Applicant.

Regardless of whether the two inventions are independent or distinct, Applicant respectfully asserts that the Examiner need not have restricted the

application. MPEP § 803 requires that "[i]f the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." Therefore, it is not mandatory to make a restriction requirement in all situations where it would be deemed proper.

In the interest of economy, for the Office, for the public-at-large, and for Applicant, reconsideration and withdrawal of the restriction requirement are requested. Applicant has no intention of abandoning any non-elected subject matter and expressly reserve the right to file one or more continuation and/or divisional applications directed to the non-elected subject matter.

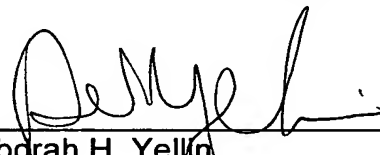
Applicant earnestly solicits favorable consideration of the above response and early passage to issue the present application. The Examiner is invited to contact the undersigned at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: July 30, 2004

By:



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